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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* HIROSHI SATO and NOBUYUKI MUKAI
9

10
11 Appeal 2008-1788
12 Application 09/909,885
13 Technology Center 3600
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16 Decided: July 25, 2008
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19 Before WILLIAM F. PATE, III, HUBERT C. LORIN, and
20 ANTON W. FETTING, *Administrative Patent Judges*.

21
22 FETTING, *Administrative Patent Judge*.
23

24 DECISION ON APPEAL

25 STATEMENT OF CASE

26 Hiroshi Sato and Nobuyuki Mukai (Appellants) seek review under
27 35 U.S.C. § 134 of a non-final rejection of claims 29-44. These, along with
28 claims 1-28 withdrawn from consideration, are the only claims pending in
29 the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3 We AFFIRM.

4 The Appellants invented a way of content delivery for improving the
5 convenience of both a content rental dealer and a customer at rental of
6 content data (Specification 1:6-11).

7 An understanding of the invention can be derived from a reading of
8 exemplary claim 29, which is reproduced below [bracketed matter and some
9 paragraphing added].

10 29. A method of delivering rented content data to
11 a customer through the internet, the method
12 comprising the steps of:

- 13 [1] defining, by the customer, a rental period
14 during which access to the content data is to
15 be permitted;
16 [2] providing from a dealer to the customer
17 a secret key
18 that is useable only during the rental period
19 defined by the customer;
20 [3] providing from the dealer to the customer
21 the content data in encrypted form through
22 the internet; and
23 [4] at the customer, decrypting and reproducing
24 the content data provided from the dealer
25 using the secret key during the rental period.
26

27 This appeal arises from the Examiner's non-final Rejection, mailed
28 August 26, 2004. The Appellants filed an Appeal Brief in support of the
29 appeal on May 11, 2006. An Examiner's Answer to the Appeal Brief was
30 mailed on August 15, 2006, but a corrected Answer was subsequently
31 mailed on May 21, 2007. A Reply Brief was filed on October 16, 2006.

PRIOR ART

The Examiner relies upon the following prior art:

Downs US 6,226,618 B1 May 1, 2001

REJECTION

Claims 29-44 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Downs.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 29-44 under 35 U.S.C. § 103(a) as unpatentable over Downs.

The pertinent issue turns on whether applying the locking and unlocking of digital content to the rental industry was a predictable use of such locking.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Downs

01. Downs is directed to securely providing data to a user's system.

The data is encrypted so as to only be decryptable by a data decrypting key, the data decrypting key being encrypted using a first public key, and the encrypted data being accessible to the user's system. (Downs 3:40-45).

02. Downs transfers the encrypted data decrypting key to a clearing house that possesses a first private key; decrypts the data decrypting key using the first private key; re-encrypts the data decrypting key using a second public key; transfers the re-encrypted data decrypting key to the user's system, the user's system possessing a second private key, which corresponds to the second public key; and decrypts the re-encrypted data decrypting key using the second private key (Downs 3:46-55).

03. Downs describes a digital certificate as used to authenticate or verify the identity of a person or entity that has sent a digitally signed message. A certificate is a digital document issued by a certification authority that binds a public key to a person or entity. The certificate includes the public key, the name of the person or entity, an expiration date, the name of the certification authority, and other information. The certificate also contains the digital signature of the certification authority (Downs 14:19-27).

04. Downs applies its technique to distribution of digital assets such as music, film, computer programs, pictures, games, and other content (Downs 1:52-55).

Facts Related To The Level Of Skill In The Art

05. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of encryption, secure processing, rental of electronic information, systems analysis, or programming. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he

absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

06. Those of ordinary skill in the rental management arts knew that at the time of the invention, automobiles and hotel rooms were rented for periods defined by a rental period selected by a customer.

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be

1 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
2 must do so by placing such definitions in the specification with sufficient
3 clarity to provide a person of ordinary skill in the art with clear and precise
4 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
5 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the
6 specific terms used to describe the invention, this must be done with
7 reasonable clarity, deliberateness, and precision; where an inventor chooses
8 to give terms uncommon meanings, the inventor must set out any
9 uncommon definition in some manner within the patent disclosure so as to
10 give one of ordinary skill in the art notice of the change).

11 *Obviousness*

12 A claimed invention is unpatentable if the differences between it and
13 the prior art are “such that the subject matter as a whole would have been
14 obvious at the time the invention was made to a person having ordinary skill
15 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
16 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14
17 (1966).

18 In *Graham*, the Court held that the obviousness analysis is bottomed
19 on several basic factual inquiries: “[1] the scope and content of the prior art
20 are to be determined; [(2)] differences between the prior art and the claims at
21 issue are to be ascertained; and [(3)] the level of ordinary skill in the
22 pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*,
23 127 S.Ct. at 1734. “The combination of familiar elements according to
24 known methods is likely to be obvious when it does no more than yield
25 predictable results.” *KSR* at 1739.

1 “When a work is available in one field of endeavor, design incentives
2 and other market forces can prompt variations of it, either in the same field
3 or a different one. If a person of ordinary skill can implement a predictable
4 variation, § 103 likely bars its patentability.” *Id.* at 1740.

5 “For the same reason, if a technique has been used to improve one
6 device, and a person of ordinary skill in the art would recognize that it would
7 improve similar devices in the same way, using the technique is obvious
8 unless its actual application is beyond his or her skill.” *Id.*

9 “Under the correct analysis, any need or problem known in the field
10 of endeavor at the time of invention and addressed by the patent can provide
11 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

12 *Automation of a Known Process*

13 It is generally obvious to automate a known manual procedure or
14 mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*
15 *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary
16 skill in the art would have found it obvious to combine an old
17 electromechanical device with electronic circuitry

18 to update it using modern electronic components in
19 order to gain the commonly understood benefits of
20 such adaptation, such as decreased size, increased
21 reliability, simplified operation, and reduced cost
22 The combination is thus the adaptation of an
23 old idea or invention . . . using newer technology
24 that is commonly available and understood in the
25 art.

26
27 *Id.* at 1162.
28

ANALYSIS

*Claims 29-44 rejected under 35 U.S.C. § 103(a) as unpatentable over
Downs.*

The Appellants argue these claims as a group.

Accordingly, we select claim 29 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Downs described all of the limitations of
claim 29 except for the customer defining of the period in limitation [1].

The Examiner implicitly found that this was no more than extending Downs’
expiration date to established business practice of rentals. The Examiner
concluded that it would have been obvious to a person of ordinary skill in
the art to have accordingly adapted Downs’ expiration date to a user chosen
time (Answer 4).

The Appellants contend that Downs does not refer to rental periods or
periods defined by a customer (Appeal Br. 3:Bottom ¶ - 4:Top ¶). The
Appellants also contend that the Examiner has provided no evidence for
such established business practices (Appeal Br. 5).

We disagree with the Appellants. First we find that none of the
remaining limitations are under contention and that Downs does describe
these limitations (FF 01 & 02). We further find that Downs attaches an
expiration date to its certificates (FF 03). Thus, Downs already has the logic
to unlock digital content only during a particular time period.

The Examiner also found that an example of the business practice the
Examiner was referring to was the rental industry, and noted the car rental
industry which provides a key only during a user selected time period, viz.
the rental period (Answer 4-5). We agree that keys for auto rentals are

provided during customer selected time periods. Another, example more closely associated with electronic keys would have been hotel rooms using electronic card keys. The Appellants argue that car rentals are not analogous because physical keys must be returned. While such keys may need to be returned, the business practice in auto rentals does demonstrate that one of ordinary skill knew that usage of items could be preferably restricted to a customer defined period. We further find, that an alternate example of electronic hotel room keys also demonstrate this business practice, and are further an example of an item containing a digital key that becomes invalid outside the customer defined period.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 127 S. Ct. at 1740.

Thus, claim 29 is no more than practicing Downs in a rental industry, which is a predictable industry for media content such as music, film, computer programs, pictures, and games (FF 04). The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 29-44 under 35 U.S.C. § 103(a) as unpatentable over Downs.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 29-44 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

On this record, the Appellants are not entitled to a patent containing claims 29-44.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 29-44 under 35 U.S.C. § 103(a) as unpatentable over Downs is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

YOUNG & THOMPSON
209 Madison Street
Suite 500
ALEXANDRIA, VA 22314